

Serial No. **10/619,550**

Docket No. **P-0566**

Amendment dated January 16, 2007

Reply to Office Action of October 16, 2006

### **REMARKS**

Entry of the amended claims is proper under 37 C.F.R. §1.116 since the amendments: (1) place the application in condition for allowance (for the reasons discussed herein); (2) do not raise any new issues requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout prosecution without incorporating additional subject matter); (3) satisfy a requirement of form asserted in the previous Office Action; and/or (4) place the application in better form for appeal (if necessary). Entry is thus requested.

By the present response, Applicant has canceled claims 3, 6 and 11 without disclaimer and amended claims 1, 10 and 15 to further clarify the invention. Claims 1, 5, 7, 8, 10, 12 and 14-18 are pending in this application. Reconsideration and withdrawal of the outstanding rejections and allowance of the present application are respectfully requested in view of the above amendments and the following remarks.

In the Office Action, claim 11 has been objected to under 37 C.F.R. § 1.75(c) as being of improper dependent form to further limit the subject matter of a previous claim. Claims 1, 3, 5-8, 10-12 and 14-18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Admitted Prior Art (APA) in view of U.S. Patent Application Publication No. 2003/0065767 (Pardhy). Claims 1 and 5-8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over APA in view of U.S. Patent No. 5,678,229 (Seki et al.).

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Response to Arguments

The Examiner states that the recitation “a method of measuring by a terminal” was not given patentable weight because the recitation occurs in the preamble and the body of the claim does not depend on the preamble for completeness. Applicant submits that this is incorrect in that the limitations in the body of the claims of the present application recite “the TE”, “the network”, and “the terminal”, clearly referring to the recitations in the preamble. Therefore, the claims as filed in Applicant’s previously filed Amendment did depend on the preamble for completeness since they found antecedent basis for these terms in the preamble. However, Applicant has amended the claims of the present application and made clear these limitations in the body of the claims.

Further, although Applicant fails to understand the Examiners reasoning, the Examiner appears to assert that the APA discloses packets transmitted and received between a terminal equipment and a network and Pardhy discloses packets monitored by the terminal. However, as noted in Applicant’s previously filed response, Pardhy et al. discloses information being transmitted between the test equipment and the network and the test equipment performing the monitoring. To simplify for a better understanding, if the test equipment in Pardhy et al is first device and the network a second device, information is transmitted between the first device and the second device. However, the monitoring is being performed by the first device. In contrast, in the limitations in the claims of the present application, information is being transmitted

between a TE (first device) and a network (second device) and the monitoring is being preformed by a third device (mobile communications terminal). Therefore, Pardhy et al. fails to disclose or suggest packets being monitored by a terminal (third device) where the packets are transmitted and received between a terminal equipment (first device) and a network (second device). The combination with the APA disclosing packets being transmitted and received between a terminal equipment (first device) and a network (second device) does not overcome the deficiencies of Pardhy et al.

#### Claim Objections

Claim 11 has been objected to under 37 C.F.R § 1.75(c). Applicant has canceled this claim therefore rendering this objection moot.

#### 35 U.S.C. § 103 Rejections

Claims 1, 3, 5-8, 10-12 and 14-18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over APA in view of Pardhy et al. Applicant has discussed the deficiencies of each of these references in Applicant's previously filed response and reasserts all arguments submitted in that response. Applicant respectfully traverses these rejections and provides the following additional remarks.

Regarding claims 1, 10 and 15, Applicant submits that none of the cited references, taken alone or in any proper combination, disclose suggest or render obvious the limitations in the combination of each of these claims. For example, the Examiner asserts that the APA, Fig. 2

discloses monitoring packets received or transmitted between the TE and the network at the terminal as recited in the claims of the present application. However, as noted in Applicant's previously filed response, the APA merely discloses transfers between the TE and the MT where a communication provider performs the calculation of the number of packets. This is not monitoring at a mobile communications terminal, packets received or transmitted between a terminal equipment and a network, as recited in the claims of the present application.

Further, the Examiner asserts again that the APA in Fig. 2 and page 3, lines 11-15 discloses cumulatively counting a number of all packets excluding packets added during a protocol stack setting process. However, as noted in Applicant's previously filed response, and noted above, the APA merely discloses the communication provider performs a calculation of the number of packets. This is not cumulatively counting at the mobile communications terminal a number of all packets, as recited in the claims of the present application. Further, neither the APA nor Pardhy et al. disclose or suggest the counting allowing the mobile communications terminal to determine a service data amount received or transmitted at the TE. Pardhy et al. merely discloses a computer 14 sending instructions to a test equipment 10 to initiate pinging of elements on a network 16. This has nothing to do with a mobile communications terminal, as recited in the claims of the present application or counting at the mobile communication terminal.

The Examiner admits that the APA does not disclose or suggest measuring, counting and displaying all by the terminal, but asserts that Pardhy et al. discloses these limitations. However, as has been noted previously, Pardhy et al. does not disclose or suggest these limitations in the claims of the present application. Pardhy et al. does not disclose or suggest a mobile communication terminal or monitoring, at a mobile communication terminal, packets being received or transmitted between a TE and a network, or cumulatively counting at the mobile communications terminal a number of all packets, or displaying the counted packets on a display of the mobile communications terminal.

Further, Applicant submits that one of ordinary skill in the art would have no motivation to combine the APA, which relates to a call connection networking being performed between a terminal equipment and PDSN using a mobile terminal as a modem, with Pardhy et al. that relates to multiple ping management where a personal computer instructs a piece of test equipment to initiate a ping operation to a network. These two have no commonality and come from completely different fields and solve completely different problems. Further, since there is no suggestion in either reference to make this combination, the Examiner appears to have used impermissible hindsight in making these rejections.

The Federal Circuit has forbidden the use of hindsight in the selection of references that comprise the case of obviousness. See, In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). Moreover, as the Federal Circuit has stated in In re Rouffet, 47

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USPQ2d 1453 (Fed. Cir. 1998) at pages 1457 and 1458:

As this court has stated, "virtually all [inventions] are combinations of old elements." Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also Richdel, Inc. v. Sunspool Corp., 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, the court has required the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Applicant respectfully submits that the Office Action relies on impermissible hindsight as there is no suggestion in the prior art for the features and/or combinations. That is, it is well-founded that when a rejection depends on a combination of prior art references, there must be some teachings, suggestion, or motivation to combine the references. See ACH Hospital

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Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) and In re Geiger, 815 F.2d, 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). Applicant believes that there is no teaching, suggestion, or motivation to combine the references and the rejection of all the claims should be withdrawn at least for this reason. Applicant further believes that the Office Action relies on impermissible hindsight to combine the features of the applied references (as well as the “non-applied references”). That is, there is no suggestion in the references to make the combination. Rather, the only motivation is provided in Applicant’s own specification. The Office Action can not use Applicant’s own specification as a “road map” to find the claimed features. As stated in In re Gorman, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991), the references themselves must provide some teaching whereby the Applicant’s combination would have been obvious. The Office Action therefore relies on impermissible hindsight. The applied references do not contain any teaching whereby the claimed features would have been obvious. Additionally, the Office Action clearly relies on a piecemeal reconstruction of the prior art in order to find claimed features. In view of this, the combination and rejections are improper and should be withdrawn.

Regarding claims 3, 5-8, 12, 14 and 16-18, Applicant submits that these claims are dependent on one of independent claims 1, 10 and 15 and, therefore, are patentable at least for the same reasons noted previously regarding these independent claims.

Accordingly, Applicant submits that none of the cited references, taken alone or in any proper combination, disclose suggest or render obvious the limitations in the combination of each of claims 1, 3, 5-8, 10, 12 and 14-18 of the present application. Applicant respectfully requests that these rejections be withdrawn and that these claims be allowed.

Claims 1 and 5-8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over APA in view of Seki et al. Applicant respectfully traverses these rejections.

Seki et al. discloses that a battery-powered accessory monitors an output voltage reduction of the battery as well as the amount of transmitting/receiving data at all times. When a voltage drop of the battery is detected, the accessory displays communication information including the amount of data which have been sent or received by that time. The data transmission brings to a halt at the time when the battery voltage drop is detected. Since a user can easily obtain the communication information through the display, it is immediately determined whether all the data have been transmitted. Furthermore, the user can easily discriminate the data including possible errors due to the battery voltage drop from all the data received. After a battery is restored to a sufficient voltage, the data transmission is resumed automatically. The data may be retransmitted from the following data.

Regarding claim 1, Applicant submits that none of the cited references, taken alone or in any proper combination, disclose suggest or render obvious the limitations in the combination of this claim. For example, for reasons noted previously, the APA does not disclose or suggest the



limitations in claim 1 of the present application. Further, the Examiner admits that the APA does not disclose the measuring, monitoring and the displaying being performed by the terminal, but asserts that Seki et al. discloses these limitations. However, Seki et al. does not disclose or suggest displaying the counted number of packets on a display of the mobile communication terminal, the counted packets displayed on the terminal including only data in a payload of a transmission protocol layer. Initially, the battery-power accessory in Seki et al. is not a mobile communications terminal, as recited in the claims of the present application. Further, Seki et al. does not disclose or suggest displaying counted packets where the counted packets include only data in a payload of a transmission control protocol layer. On page 6 and 7 of the Office Action, the Examiner appears to assert that the APA and Pardhy et al. disclose these limitations in Applicant's background page 3, lines 11-14, and Pardhy et al., abstract last sentence and paragraphs 25 and 26. However, as noted previously, the APA discloses the communication provider calculating the number of packets. Further, as noted previously, Pardhy et al. does not disclose or suggest a mobile communications terminal performing the monitoring counting and displaying as recited in the claims of the present application. Further, Pardhy et al. discloses that data parsed and collected during a ping operation may include instrument addresses, network addresses, time stamps and packet counts(see, paragraph 25). This is not displaying counting packets that include only data in payload of a transmission control protocol layer. Further, Pardhy disclosing that a parsed process parses the revived data packets and extracts data

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pertinent to the instrument where the received packets relates to packets received by the test instrument 10. As noted previously, test equipment 10 in Pardhy et al. is not a mobile communications terminal, as recited in the claims of the present application.

Regarding claim 5-8, Applicant submits that these claims are dependent on independent claim 1 and, therefore, are patentable at least for the same reasons noted previously regarding these independent claims.

Accordingly, Applicant submits that none of the cited references, taken alone or in any proper combination, disclose suggest or render obvious the limitations in the combination of each of claims 1 and 5-8 of the present application. Applicant respectfully requests that these rejections be withdrawn and that these claims be allowed.

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### **CONCLUSION**

In view of the foregoing amendments and remarks, Applicant submits that claims 1, 5, 7, 8, 10, 12 and 14-18 are now in condition for allowance. Accordingly, early allowance of such claim is respectfully requested. If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, Frederick D. Bailey, at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,  
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